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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,819	01/31/2005	Yutaka Shibui	01165.0935	4699
22852	7590	06/09/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SCHWARTZ, DARREN B	
			ART UNIT 2435	PAPER NUMBER
			MAIL DATE 06/09/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,819

**Applicant(s)**

SHIBUI ET AL.

**Examiner**

DARREN SCHWARTZ

**Art Unit**

2435

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 12-22-08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 May 2009 has been entered.

***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Pat 6564005 B1), hereinafter referred to as Berstis, in view of Molva et al (U.S. Pat 5347580 A), hereinafter referred to as Molva.

Re claim 1: Berstis teaches a device installed in a machine tool for preventing unauthorized use of optional operation programs in the machine tool (Fig 1; col 11, lines 5-8), comprising:

a storage section [Fig 2, elt 220] configured to store the optional operation programs (col 5, lines 53-55);

a display section [Fig 1A, elt 105] (col 3, lines 31-32) configured to display a first program-selection image [Fig 3, elt 310; Fig 4: "Master User Menu"] and a second program-selection image [Fig 7, elt 410; Fig 8: "User Menu"] (col 7, lines 23-30; col 8, lines 9-14), separately from each other (Fig 4, Fig 8; only one of the "Master User Menu" or "User Menu" can be displayed at any one time; Fig 4 and Fig 8 are clearly distinct), for a desired one of said operation programs to be selected on the respective first and second program-selection images (Fig 4: "Master User Menu;" col 7, lines 25-30) and second program-selection images (Fig 8: "User Menu;" col 8, lines 11-14); and

a processing section [Fig 1A, elt 102] configured to receive a device-inherent password or a machine-tool inherent password (col 7, lines 13-15; col 8, lines 5-8; col 10, lines 6-10 and lines 58-63);

read out, when receiving the device-inherent password [master user password] (col 3, lines 31-32), said desired operation program selected on said first program-selection image from said storage section (col 5, lines 53-55; col 7, lines 23-35 and lines 43-46) and bring said desired operation program into a usable state (col 31-35: the "New user Menu" is shown), and

read out, when receiving the machine-tool inherent password [user password], said desired operation program selected on said second program-selection image from said storage section (col 5, lines 53-55; col 8, lines 21-22) and bring said desired operation program into usable state (col 8, lines 15-21);

However, Berstis does not expressly disclose the device-inherent password is set by a manufacturer of the device and the machine-tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password.

Molva teaches the device-inherent password is set by a manufacturer of the device and the machine-tool inherent password is set by a manufacturer of the machine tool (col 4, lines 56-64), and is different from the device-inherent password (col 7, lines 49-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Berstis with the teachings of Molva, for the purpose of providing electronic devices with a plurality of embedded and unique credentials for authentication users and the prevention of credential tampering.

Re claim 2: The combination of Berstis and Molva further teaches said storage section includes a program storage area for storing said various optional operation programs and an image storage area for storing said first and second program-selection images (Berstis: col 5, line 53-55; col 6, lines 28-35 and lines 38-40); and

wherein said processing section processes to read out (Berstis: col 3, lines 31-32), when said device-inherent password [Berstis: master user password] is input (Berstis: Fig 3, elts 302 & 304; col 7, lines 14-16), said first program-selection image

from said image storage are (Berstis: col 5, lines 53-55; col 7, lines 23-35 and lines 43-46) and make said display section display said first program-selection image (Berstis: Fig 3, elt 310; col 7, lines 23-30), and

read out (Berstis: col 3, lines 31-32), when said machine-tool inherent password [user password] is input (Berstis: Fig 7, elts 402 & 404; col 8, lines 5-8), said second program-selection image from said image storage area and make said display section display said second program-selection image (Berstis: Fig 7, elt 410; col8, lines 9-13).

Re claim 3: The combination of Berstis and Molva further teaches wherein said processing section processes to bring, when selection of said operation program is performed respectively on said first and second program-selection images, only said desired operation program selected on said second program-selection image into a usable state (Berstis: col 6, lines 54-65).

Re claim 6: The combination of Berstis and Molva further teaches said first and second program-selection images have an image configuration identical to each other (Berstis: Fig 4 and Fig 7 have a menu title name and a plurality of options for the user from which he/she may choose).

Re claim 7: The combination of Berstis and Molva further teaches configured to be incorporated into a numerical control device (Berstis: col 5, lines 2-5; col 11, lines 17-20).

Re claim 8: The combination of Berstis and Molva further teaches each of said first and second program-selection images displays a list of program names of said

various optional machine tool operation programs (Berstis: Figures 4, 5, 6 and 8 all show various menus).

Re claim 9: The combination of Berstis and Molva further teaches said second program-selection image is prepared by the manufacturer of the machine tools (Berstis: col 5, lines 53-55).

2. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Pat 6564005 B1), hereinafter referred to as Berstis, in view of Molva et al (U.S. Pat 5347580 A), hereinafter referred to as Molva, in further view of Arnold (U.S. Pat 5956408 A), hereinafter referred to as Arnold.

Re claim 4: The combination of Berstis and Molva teaches an interface section connectable to an external storage unit storing specific data (Berstis: col 2, lines 31-35); wherein said processing section processes, through said interface section, said desired operation program selected on said second program-selection image into a usable state (Berstis: col 10, lines 56-64).

However, Arnold teaches: to identify a validity (Fig 3, elt 160: digital signature) of said specific data (Fig 3, elt 100; col 6, lines 66-67) stored in said external storage unit (col 6, lines 62-65) and bring (Fig 3, elts 140 & 180), only when said specific data are judged to be valid (Fig 3, elts 160, 170 & 180; col 7, lines 31-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified Berstis and Molva with the teachings of

Arnold to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium.

Re claim 5: The combination of Berstis and Molva teaches an interface section connectable to an external computer in turn connectable to an external storage unit storing specific data (Berstis: col 2, lines 31-35); said desired operation program selected on said second program-selection image into a usable state (Berstis: col 10, lines 56-64).

However, Arnold teaches: wherein said processing section processes to bring, only when said external computer judges said specific data stored in said external storage unit (col 6, lines 62-65) to be valid (Fig 3, elts 160, 170 & 180; col 7, lines 31-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified the teachings of Berstis and Molva with the teachings of Arnold to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully



consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./  
Examiner, Art Unit 2435  
/Kimyen Vu/  
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